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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,200	04/15/2004	Robert A. Ottaviani	GP-302034	1161

7590 10/25/2004

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EXAMINER

SAKRAN, VICTOR N

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 10/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/826,200

Applicant(s)

OTTAVIANI ET AL.

Examiner

VICTOR N SAKRAN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 1-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/15/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 18 and 21, are objected to because of the following informalities:

Since the term “and/or” as recited in said claims is vague and is not a positive recitation. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

- 1. Determining the scope and contents of the prior art.**
- 2. Ascertaining the differences between the prior art and the claims at issue.**
- 3. Resolving the level of ordinary skill in the pertinent art.**
- 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.**

Claims 18-21, are rejected under 35 U.S.C. 103(a) as being unpatentable over

Marmaropoulos U. S. Patent No. 6,598,274 (of record) in view of Elie et al U. S. Patent No. 5,814,999 (cited by Applicant).

Marmaropoulos discloses the general combination claimed of a releasable fastener system comprising a loop portion including a support and a loop material disposed on the surface of said loop support, and a hook portion including a hook support and a plurality of J-shaped hook elements disposed on the surface of said hook support in combination with means (activation device) for changing the shape orientation and/or flexural modulus in order to reduce a shear force and/or a pull-off force of an engaged hook and loop portions which is obviously and inherently perform the desired function for providing a variable damping capability to said releasable fastener system; see Figures 1-5; the abstract; column 2, lines 38-67; column 5, lines 45-63; column 6, lines 25-39; claims 1-5 and 12, except that the plurality of hook elements comprises a magnetorheological elastomer including a magnetic signal for changing the shape orientation and/or flexural modulus of the hook elements upon receipt of said magnetic signal. Elie et al teaches the use of magnetorheological elastomer including magnetic field, wherein said magnetorheological elastomer is adapted to change its shape orientation and/or flexural modulus upon receipt of the magnetic field (signal); see Figures 2, 3; the abstract; column 1, lines 58-65; column 2, lines 5-16; column 4, lines 50-57; claims 1, 9 and 11.

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the plurality of the hook elements in Marmaropoulos with a magnetorheological elastomer in order to be able to change its shape orientation and/or its flexural modulus upon the receipt of a magnetic signal, in the manner disclosed, taught and suggested by Elie et al, especially, since such modification involves only routine skill in the art.

Applicant is reminded that in considering the disclosure of these references, it is proper to take into account not only specific teaching of these references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom; see *In re Preda*, 401 F2d 825, 826, 159 USPQ 342,344 (CCPA1968).

Moreover, the use of different materials as recited in claim 19, is also considered to be no more than an obvious matter of design choice within the skill in the art, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. See *In Re Leshin*, 125 USPQ 416.

Furthermore, the term "for" as recited in the claim 18, perform a function and is not a positive limitation but only requires the ability to so perform and it

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does not constitute a limitation in any patentable sense; see In Re Hutchison, 69 USPQ 138.

Moreover, it has been held that a recitation with respect to the manner in which a claimed device is intended to be employed does not differentiate the claimed device from a prior art apparatus satisfying the claimed structural limitation ; see Ex parte Masham, 2 USPQ 2d 1647 1987.

Claims 1-17, have been canceled by the preliminary amendment filed by Applicant on April 15, 2004

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant's attention is directed to the prior art of record, as showing structure related to Applicant's disclosed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICTOR N SAKRAN whose telephone number is 703-308-2224. The examiner can normally be reached on 6:30 AM - 5:00 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. swann can be reached on 703-308-4115. The fax

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phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

October 20, 2004


VICTOR N SAKRAN
Primary Examiner
Art Unit 3677